

REMARKS

I. Status of claims

By this Amendment, Applicants add new claims 44-48. Claims 1-48 are therefore pending in this application.

In the Office Action of April 30, 2004,¹ claims 1-21 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter; claims 1-14, 16-19, 22-25, 27-30, and 33-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over PCT International Publication No. WO 01/18674 A2 (“*Maloney*”) in view of U.S. Patent Application Publication No. US 2002/0007276 A1 (“*Rosenblatt*”); and claims 15, 20, 21, 26, 31, 32, 42, and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Maloney* and *Rosenblatt* in view of PCT International Publication No. WO 02/05249 (“*Orpaz*”). Applicants address the rejections and new claims below.

II. Rejection of claims 1-21 under 35 U.S.C. § 101

Applicants traverse the rejection of claims 1-21 under 35 U.S.C. § 101 for the following reasons.

According to the Examiner, claims 1-21 do not include recitations “in the technological arts” (OA at 2). The Examiner alleges that the claim recitations are “abstract ideas which can be performed mentally without interaction of a physical structure” (OA at 2). The Examiner concludes that the “claimed invention is directed to an abstract idea ...” and that the claims are therefore not permitted under 35 U.S.C. § 101. Applicants respectfully disagree.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on “the essential characteristics of the subject matter, in particular, its practical utility.” *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998). If a claim includes recitations that produce “a concrete, tangible and useful result,” the claim is not abstract and has practical utility. *See State Street*, 149 F.3d at 1373; *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999). And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

Furthermore, Applicants point out that whether or not a process can be performed “without physical and/or computer means” is not dispositive of determining whether a claimed process is statutory. In fact, the Federal Circuit indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T*, F.3d at 1359.

Initially, Applicants point out that the Examiner failed to establish a *prima facie* showing that the claimed invention is an “abstract idea.” The Examiner’s conclusory statements that the claims do not “recite a limitation in the technological arts” and that the recitations “are abstract ideas which can be performed mentally without interaction of a physical structure” are wholly unsupported and do not by themselves establish that the claims are directed to abstract ideas. Because the Examiner failed to provide any evidence to support these allegations in the Office Action, the rejection of claims 1-21 under 35 U.S.C. § 101 should be withdrawn.

In addition, Applicants submit that claims 1-21 are not abstract but rather statutory. Claims 1-21 include recitations that produce “concrete, tangible and useful” results and therefore, despite the Examiner’s allegations, accomplish a practical application and are not abstract. *State Street*, 149 F.3d at 1375.

Independent claim 1 recites “an electronic beauty analysis method” including, *inter alia*:

maintaining beauty information in a data structure;

selecting for presentation to the subject at least some beauty information maintained in the data structure based on ... received information; [and]

presenting to the subject an image of a virtual beauty consultant.

Claim 1, at least by virtue of the above features, is not abstract and is within the technological arts. Maintaining beauty information in a data structure is a useful, non-abstract result that facilitates, for example, a selection and presentation of information to a subject. The claimed “selecting” and “presenting” are also useful, non-abstract results. Further, contrary to the Examiner’s allegations, claim 1 does define subject matter within the technological arts. An “electronic beauty analysis method” that maintains and selects information using a “data structure” is clearly within the technological arts and may involve “interaction of a physical structure.” Moreover, as explained above, whether or not the claims include physical limitations is not dispositive of determining whether a claimed process is statutory.

For at least the foregoing reasons, Applicants request withdrawal of the rejection of claim 1, and its dependent claims 2-21, under 35 U.S.C. § 101.

III. Rejection of claims 1-14, 16-19, 22-25, 27-30, and 33-41 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 1-14, 16-19, 22-25, 27-30, and 33-41 under 35 U.S.C. § 103(a) based on *Maloney* and *Rosenblatt* because *prima facie* obviousness has not been established with respect to these claims. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either

in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

The Examiner conceded (OA at 3) that *Maloney* fails to disclose “presenting to the subject an image of a virtual beauty consultant; and causing the image of the consultant to present to the subject the beauty information selected for presentation,” as recited in claim 1. In rejecting Applicants’ claims, the Examiner relied on *Rosenblatt* in attempt to cure *Maloney*’s deficiencies.

Even if all of the features of claim 1 could be found in some combination of *Maloney* and *Rosenblatt*, *prima facie* obviousness has not been established at least because the requisite motivation to combine those references is lacking. Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action provides no “substantial evidence” to support the attempted combination of *Maloney* and *Rosenblatt*. For example, the Examiner has not shown, by substantial evidence, that a skilled artisan considering the cited references, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references in a

manner resulting in Applicants' claimed combination. The Examiner merely provides a description of how *Rosenblatt* allegedly teaches certain features without a proper motive for combining *Rosenblatt* with *Maloney*.

The Examiner merely alleges that a skilled artisan would combine the references "because it would attract to e-shopping those customers who prefer to communicate face-to-face with a salesperson . . ." (OA at 3). This conclusory allegation is not properly supported by evidence on the record and does not establish that a skilled artisan would have been motivated to combine the references. The Examiner fails to note any disclosure from *Maloney* or *Rosenblatt* to support the alleged motivation. In addition, the assertion that combining the references in a manner resulting in Applicants' claimed invention would attract a certain customer group does not by itself establish that a skilled artisan, not having the benefit of Applicants' disclosure, would have been motivated to combine the prior art in that manner.

M.P.E.P. § 2143 specifies that the requirements for establishing *prima facie* obviousness must "be found in the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001). Further, M.P.E.P. § 2142 articulates:

Knowledge of applicant's disclosure must be put aside....
[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicants submit that the conclusions in the Office Action pertaining to motivation were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used to reconstruct the prior art. Applicants submit that the conclusions in the Office Action constitute improper hindsight reasoning.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claim 1. The Examiner rejected independent claims 1, 22, and 33 together without

separately addressing certain features of claims 22 and 33 (OA at 3). Regardless, Applicants submit that *prima facie* obviousness has not been established with respect to claims 22 and 33 for at least reasons similar to those presented above.

Each of claims 2-14, 16-19, 23-25, 27-30, and 34-41 depends from independent claim 1, 22, or 33. For at least the same reasons as those presented for claims 1, 22, and 33, *prima facie* obviousness has not been established with respect to dependent claims 2-14, 16-19, 23-25, 27-30, and 34-41. Applicants thus request withdrawal of the rejection of claims 1-14, 16-19, 22-25, 27-30, and 33-41 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

IV. Rejection of claims 15, 20, 21, 26, 31, 32, 42, and 43 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 15, 20, 21, 26, 31, 32, 42, and 43 under 35 U.S.C. § 103(a) based on *Maloney*, *Rosenblatt*, and *Orpaz* for at least the following reasons.

The Office Action alleged (OA at 5) that *Maloney* and *Rosenblatt* disclose all of the features of claims 15, 20, 21, 26, 31, 32, 42, and 43 expect “that said pre-recorded human image is an image of an actual human being.” In rejecting the claims, the Office Action relied on *Orpaz* in an attempt to cure the deficiencies of *Maloney* and *Rosenblatt*.

Each of claims 15, 20, 21, 26, 31, 32, 42, and 43 depends from claim 1, 22, or 33. As explained above in connection with claims 1, 22, and 33, the requisite motivation to combine *Maloney* and *Rosenblatt* is lacking. For at least this reason, *prima facie* obviousness has not been established with respect to claims 15, 20, 21, 26, 31, 32, 42, and 43 and the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

Further, the requisite motivation to combine *Orpaz* with the proposed *Maloney*-*Rosenblatt* combination is lacking. The Examiner has not shown, by substantial evidence, that a skilled artisan considering the cited references, and not having the benefit of Applicants’ disclosure, would have been motivated to combine the references. The Examiner merely alleges

that a skilled artisan would have combined the references “because it would . . . closely simulate the results of using said offered beauty product . . . ” (OA at 5). This conclusory allegation is not properly supported by evidence on the record and does not establish that a skilled artisan would have been motivated to combine the references. Again, Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, Applicants’ claims were improperly used to reconstruct the cited references. For at least this additional reason, *prima facie* obviousness has not been established with respect to claims 15, 20, 21, 26, 31, 32, 42, and 43 and the rejection of these claims under 35 U.S.C. § 103(a) should be withdrawn.

In addition, *prima facie* obviousness has not been established with respect to claims 15, 20, 21, 26, 31, 32, 42, and 43 because, even if *Maloney*, *Rosenblatt*, and *Orpaz* were combined, the resultant combination would not yield all of the features of these claims.

Claim 15 recites, *inter alia*, “wherein presenting to the subject an image of a virtual beauty consultant involves causing a pre-recorded image of an actual human being to be displayed to the subject.” As affirmed by the Examiner, neither *Maloney* nor *Rosenblatt*, nor any combination thereof, teaches or suggests this feature. *Orpaz* does not cure the deficiencies of *Maloney* and *Rosenblatt*. *Orpaz* describes a system in which users can “try and buy” make-up products and accessories via a computer (page 3). The system uses digital images of the user to “demonstrate how make-up and accessory products will appear on the user” (page 3). *Orpaz* does not present to the subject an image of an actual human being as a *virtual beauty consultant*, as claimed. Instead, *Orpaz* merely mentions presenting an image of the user to “demonstrate how make-up and accessory products will appear on the user.” Accordingly, neither *Maloney*,

Rosenblatt, nor *Orpaz*, nor any combination thereof, teaches or suggests all of the features of claim 26.

Claim 20 recites, *inter alia*, “presenting to the subject an image of a virtual user receiving the beauty information [presented by an image of a virtual beauty consultant].” *Maloney* and *Rosenblatt* (whether taken alone or in combination) do not teach or suggest this feature. Further, although *Orpaz* mentions digital images of the user, it does not teach or suggest “presenting to the subject an image of a virtual user receiving the beauty information [presented by an image of a virtual beauty consultant],” as claimed. Accordingly, neither *Maloney*, *Rosenblatt*, nor *Orpaz*, nor any combination thereof, teaches or suggests all of the features of claim 20 or claim 21, which depends from claim 20.

Claim 26 recites, *inter alia*, “[causing] a pre-recorded image of an actual human being [to appear as audibly presenting to the subject at least one of the queries from the data structure, to thereby conduct the interactive beauty analysis with the subject].” Neither *Maloney* nor *Rosenblatt*, nor any combination thereof, teaches or suggests this feature. Further *Orpaz* does not cure these deficiencies. *Orpaz*’s system uses digital images of the user to “demonstrate how make-up and accessory products will appear on the user,” not to conduct an interactive beauty analysis with the subject, as claimed. Accordingly, neither *Maloney*, *Rosenblatt*, nor *Orpaz*, nor any combination thereof, teaches or suggests all of the features of claim 26.

Claim 31 recites, *inter alia*, “presenting to the subject an image of a virtual user receiving the beauty information [presented by a displayed human image].” *Maloney* and *Rosenblatt* (whether taken alone or in combination) do not teach or suggest this feature. Further, although *Orpaz* mentions digital images of the user, it does not teach or suggest “presenting to the subject an image of a virtual user receiving the beauty information [presented by a displayed human

image]," as claimed. Accordingly, neither *Maloney*, *Rosenblatt*, nor *Orpaz*, nor any combination thereof, teaches or suggests all of the features of claim 31 or claim 32, which depends from claim 31.

Claim 42, although of different scope, includes features similar to those of claims 20 and 31 noted above. For at least reasons similar to those presented above in connection with claims 20 and 31, neither *Maloney*, *Rosenblatt*, nor *Orpaz*, nor any combination thereof, teaches or suggests all of the features of claim 42 or claim 43, which depends from claim 42.

For at least the foregoing reasons, *prima facie* obviousness has not been established with respect to claims 15, 20, 21, 26, 31, 32, 42, and 43. Applicants thus request withdrawal of the rejection under 35 U.S.C. § 103(a) and the timely allowance of these claims.

V. New claims 44-48

New claims 44-48 depend directly or indirectly from claim 1. Applicants submit that these claims are allowable at least by virtue of such dependence. Further, neither *Maloney*, *Rosenblatt*, nor *Orpaz*, nor any combination thereof, teaches or suggests all of the features of new claims 44-48. Applicants therefore request the timely allowance of the new claims.

VI. Conclusion

The claimed invention is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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